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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,547	03/28/2001	Yoshifusa Togawa	1075.1152	9434

21171 7590 05/06/2005
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,547

Applicant(s)

TOGAWA ET AL.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Handwritten mark resembling a stylized 'H' or 'N'.

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1. Claims 1-28 are presented for examination.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly [U.S. Patent No. 6,427,164].

4. Reilly discloses (e.g., see Fig. 2) the invention substantially as claimed. Taking claim 1 as exemplary claims, the reference discloses a mail system comprising: a) a mail source (sending server, abstract (line 5)) from which an e-mail is sent; b) one or more destinations (recipient, a receiving server) which receive the e-mail from the mail server at their respective mail address (e.g., see the abstract, cols. 3-4); c) a mail address manager (Fig. 2, the abstract, cols. 3-4) managing the respective mail addresses of the destinations, the mail address manager (forwarding server 300) being operative, in response to updating of the mail address (forwarding address, abstract (line 3), cols. 3-4) of at least one destination, to register ("the recipient ... has left a forwarding address", abstract, col. 4 (lines 14-15)) a new destination mail address in correlation with such old destination address; and a mail sending section (sending e-mail server 140 and forwarding server 300) sending a particular e-mail, which is addressed to said old destination mail address, to said new destination mail address when said new destination mail address is registered in said mail address manager

(e.g., see col. 8 (line 15) to col. 9 (line 58)), and to said old destination mail address when said new destination mail address is not registered in said mail address manager.

5. Reilly does not explicitly mention either the term "mail source" or "mail address manager". However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that Reilly's sending server is obviously the mail source as claimed because the e-mail is received from Reilly's sending server. Moreover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that Reilly's e-mail servers 140 and 240 are obviously the mail address manager as claimed because Reilly's e-mail servers perform similar operations as claimed mail address manager.

6. As to claim 2, Reilly discloses the mail address manager (e.g., see Fig. 2, the abstract, and cols. 3-4) is a mail server (e-mail server 140) which receives an e-mail from the mail source and sends the e-mail to at least one destination mail address.

7. As to claim 3, Reilly discloses the mail address manager is a plurality of mail server (140, 240 of Fig. 2) which manages the mail address of two or more destinations separately (the abstract, cols. 3-4).

8. As to claim 5, Reilly discloses a notifying section notifying the mail source that the mail address of at least one destination has been updated (e.g., see the abstract, lines 8-9).

9. As to claim 6, Reilly discloses a mail address rewriting section (see the abstract, lines 8-11) rewriting the mail address of at least one destination in an e-mail address book when the mail source is notified by the notifying section that mail address of the at least one destination has been updated (e.g., see the abstract, lines 8-11, cols. 3-4).

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10. As to claim 7, Reilly discloses a mail storing section temporarily storing a particular e-mail (e.g., see col. 3, lines 29-30), which is addressed to the old destination mail address, until the new destination mail address is registered by the mail address manager (e.g., see col. 4, lines 14-15), wherein said mail sending section (sending e-mail server 140 and forwarding server 300) sending the particular e-mail to said new destination mail address, when said new destination mail address is registered in said mail address manager (e.g., see col. 8 (line 15) to col. 9 (line 58)).

11. As to claim 8, Reilly discloses the mail address manager to register the mail address of the destination and attribute information (e.g., see col. 3 (lines 27-35), col. 8 (line 15) to col. 9 (line 58)) respectively unique to the destination in correlation with each other; and when sending an e-mail to the mail address of a particular destination, said mail source inputs said attribute information unique (domain name (e.g., see col. 7, an NDR, col. 9 (lines 11-48) and) to said particular destination for substitution for the mail address of said particular destination so that the last-named e-mail is sent to said particular destination corresponding to said input attribute information.

13. As to claims 9-28, they are similar in scope as of claims 1-3 and 5-8 with the additional features of: an address list (address table) in which a plurality of destination addresses are registered (e.g., see col. 8 (lines 40-67)); a mail address rewriting section (col. 8 (line 15) to col. 9 (line 58)) and the mail address manager (e.g., a mail processing section processing e-mail data) into such a form receivable (new address corresponding to the old address) by the destination based on the last-named destination which information is stored in the storage section (address table or database or address book) (e.g., see col. 6 (line 50) to col. 9 (line 58)). Therefore, claims 9-28 are rejected for the same reasons set forth above for claims 1-3 and 5-8.

14. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action with some modification.

15. Applicant's arguments filed 11/12/04 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicants argued in substance that:

(a) Reilly is different from the present invention because Reilly teaches sending an e-mail to a second mail address when error has occurred at a first mail address. In the present invention, after an e-mail address of a destination has changed and a new e-mail address is registered by the mail address manager, the e-mail is sent to new e-mail address without occurring an error (see claim 1). Therefore, Reilly does not disclose the features recited in claim 1 of the present invention.

b) Reilly neither taught nor suggested mail processing section of claim 9,

16. In response to paragraph 15 a), the fact that applicant has recognized the different between the present invention and the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

17. In response to paragraph 15 b), Reilly discloses the mail address manager (e.g., a mail processing section processing e-mail data) into such a form receivable (new address corresponding to the old address) by the destination based on the last-named destination which information is stored in the storage section (address table or database or address book) (e.g., see col. 6 (line 50) to col. 9 (line 58)).

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

April 23, 2005



KRISNA LIM
PRIMARY EXAMINER